

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE U.S. PATENT NO. 7,470,792

Art Unit: 1626

ISSUE DATE: DECEMBER 30, 2008

Examiner: Joseph R. Kosack

APPLICATION NO: 10/526,283

FILED: SEPTEMBER 1, 2005

FOR: A NEW PROCESS FOR THE PREPARATION OF EPOTHILONE  
DERIVATIVES, NEW EPOTHILONE DERIVATIVES AS WELL AS  
NEW INTERMEDIATE PRODUCTS FOR THE PROCESS AND THE  
METHODS OF PREPARING SAME

**MS: General**

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT-POST-GRANT

Sir:

In accordance with 37 C.F.R. § 1.705(d), Applicant hereby applies for patent term adjustment under 35 U.S.C. § 154(b) of 251 days. This application is being filed within two months of the date the patent issued, as required by 37 C.F.R. § 1.705 (d).

**I. Fee**

As required by 37 C.F.R. § 1.705(b)(1), please charge Deposit Account No. 19-0314 for \$ 200.00 to cover the required fee (as defined in 37 C.F.R. § 1.18(e)). Please charge any deficiencies or any additional fees due in response to this request to Deposit Account 19-0314.

**II. Statement of the Facts Involved**

**A. Correct Patent Term Adjustment**

Applicant received the Issue Notification on December 17, 2008. United States Patent No. 7,470,792 issued on December 30, 2008, indicating a patent term adjustment of 131 days.

Patentee has calculated a patent term adjustment of 251 days based on the following facts:

### **Case Law**

In *Wyeth v. Dudas*, 2008 U.S. Dist. LEXIS 76063 (D.D.C. 2008), the District Court of the District of Columbia addressed the United States Patent and Trademark Office (USPTO) interpretation of 35 U.S.C. § 154(b)(2). The Court granted summary judgment in favor of Wyeth, determining that the USPTO misconstrued the first sentence of 35 U.S.C. § 154(b)(2)(A), and as a result, improperly denied Wyeth a portion of patent term to which Wyeth was entitled under 35 U.S.C. § 154.

In the opinion, the Court stated that "the PTO's view is that any administrative delay under § 154(b)(1)(A) overlaps any 3-year maximum pendency delay under § 154(b)(1)(B): the applicant gets credit for 'A delay' or for 'B delay,' whichever is larger, but never A + B." However, Plaintiff Wyeth argued that the § 154(b)(1)(A) and § 154(b)(1)(B) period overlap only if they occur on the same calendar day or days. The Court determined that Wyeth's construction of § 154(b)(2) was correct.

Simply put, the holding of the Court is that the excluded overlap recited in the first sentence of 35 U.S.C. § 154(b)(2)(A) only occurs if a 35 U.S.C. § 154(b)(1)(A) period and a 35 U.S.C. § 154(b)(1)(B) period run concurrently. As such, a patent holder is entitled to recoup the 35 U.S.C. § 154(b)(1)(A) period that falls outside of the 35 U.S.C. § 154(b)(1)(B) period in addition to the 35 U.S.C. § 154(b)(1)(B) period itself.

### **Relevant Dates**

The above identified application has a 35 U.S.C. §371 filing date of September 1, 2005..

The first Office Action, which was a Restriction Requirement, was mailed on May 25, 2007, resulting in a PTO delay of 205 days beyond the 14 months provided by 35 U.S.C. §154(b).

A Response to Restriction Requirement was filed by Patentee on November 7, 2007, resulting in a 74 day applicant delay.

An Office Action was mailed February 8, 2008, resulting in no PTO delay beyond the 4 months provided by 35 U.S.C. §154(b)(1)(A)(ii).

A Response by Patentee was filed May 7, 2008, resulting in no applicant delay.

A Notice of Allowance was mailed August 26, 2008.

The issue fee was paid November 25, 2008

The patent issued December 30, 2008.

Accordingly, the total PTO adjustment based on delay under 35 U.S.C. § 154(b)(1)(A) is 205 days.

The 35 U.S.C. § 154(b)(1)(B) period for U.S. Patent No. 7,470,792 began on September 1, 2008 (three years after the filing date of September 1, 2005) and ended on the date of issuance, December 30, 2008. The 35 U.S.C. § 154(b)(1)(B) period is 120 days.

There was no 35 U.S.C. § 154(b)(1)(A) delay that occurred within this 35 U.S.C. § 154(b)(1)(B) period that should be excluded from the patent term adjustment calculation under the holding of *Wyeth v. Dudas*.

Accordingly, the sum of the 35 U.S.C. § 154(b)(1)(B) and non-overlapping 35 U.S.C. § 154(b)(1)(A) delay is  $(205 + 120 \text{ days}) = 325 \text{ days}$ .

Under 35 U.S.C. § 154(b)(2)(C), the total period of PTO delay is reduced by the period of applicant delay, which is 74 days.

Accordingly, the correct patent term adjustment for the above identified application is 251 days (the difference between the total period of PTO delay under 35 U.S.C. § 154(b)(1) and applicant delay under 35 U.S.C. § 154(b)(2)(C)).

The PTA printed on the front of U.S. Patent No. 7,470,792 is only 131 days, which the USPTO is presumed to have calculated using the method considered proper before the holding of *Wyeth v. Dudas*. Applicants therefore respectfully request reconsideration of the PTA listed on the front of U.S. Patent No. 7,470,792.

#### **B. Terminal Disclaimer**

The above-identified patent is not subject to a Terminal Disclaimer.

**C. Reasonable Efforts**

Any applicant delays under 37 C.F.R. § 1.704 are set forth above. There were no other circumstances constituting a failure to engage in reasonable efforts to conclude processing of examination of the above-identified application, as set forth in 37 C.F.R. § 1.704.

Respectfully submitted,

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Date: 2/13/09